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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/293,835 04/19/99 KENNEDY J 067286/136/D

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HM12/1206

EXAMINER

HOLLINDEN, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

12/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/293,835

Applicant
Kennedy

Examiner
Gary E. Hollinden

Group Art Unit
1619



☒ Responsive to communication(s) filed on Sep 12, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 15-19, and 24-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1, 15-19, and 24-51 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit 1619

This Office Action is a response to the amendment filed on September 12, 2000 wherein claims 1 and 19 were amended, claims 11-14 and 20-23 were canceled and claims 30-51 were added. Currently, Claims 1, 15-19, and 24-51 are pending in this application. Because the new/ amended claims introduce many new conditions/ disorders into the claims, an election of species is required to identify a single ultimate disorder to continue examination:

but not

Claims 1, 15-19, and 24-51, drawn in Markush format, encompass multiple independent and patentably distinct inventions. Accordingly, a requirement to provisionally elect a single independent and patentably distinct species is made as provided for in MPEP § 803.02. It is noted that the claims encompass such final products as those set forth in claims 1 and 19.

It is considered that a Markush-type claim encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a reference anticipating one of the species would not anticipate or render obvious the other species. Further, the species are considered to be independent since they are unrelated in operation, one does not require the other for ultimate use, and the specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered to be patentably distinct from the others on the basis of its properties. Thus, the stated species are capable of supporting separate patents under 35 USC § 121.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. In the instance case, by species is meant a single condition/ disorder to be treated.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

Art Unit 1619


showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

In the event that the Markush-type claims are not found to be allowable, the examination of the claims presented will be limited to the Markush-type claims to the extent that they read on the elected species and claims directed solely to the elected species. The claims directed solely to the non-elected species will be held withdrawn from consideration. A requirement to elect a species has been held to be tantamount to a requirement for restriction under 35 USC § 121¹.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at 703/308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15 1989.

Any inquiry concerning this Office Action or any earlier Office Actions in this application should be directed to Diana Dudash whose telephone number is 703/308-2328.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-1235.



Gary E. Hollinden, Ph.D.
Primary Examiner
Group 1600

¹*In re Herrick*, 115 USPQ 412, Comm'r Pat. 1957; *In re Joyce*, 115 USPQ 412, Comm'r Pat. 1957.